

Appl. No. 10/767,599  
Amdt. dated 01/25/2007  
Reply to Office action Mailed: 11/27/2006

### **REMARKS/ARGUMENTS**

#### **Obviousness (35 USC § 103)**

The examiner has rejected claims 1-9 and 11-22 under 35 U.S.C. 103(a) as being unpatentable over Watson, U.S. Patent 6,604,840 in view of Yu, U.S. Patent 6,526,680 and Dalton et al. US 20040201992A1. The applicant disagrees for the following reasons:

- 1) The examiner contends that Watson teaches a variable power control device (photoelectric light switch 70). While Watson does disclose in column 3 lines 64 to 65, the light switch is not utilized as a variable power control device. (emphasis added) In column 4 lines 1-9 the light switch 70 is described as...

The light sensor 70 is electrically connected to the battery 44 in such that current is permitted to energize the light sources 50 only when the light sensor 70 detects a level of ambient light that is below a predetermined light level. It is understood that the lighting apparatus 10 could function without a light sensor 70 or even if the light sensor is not functioning. In other words, the light sources 50 may be constantly energized by the battery 44 or a manual on/off switch may be employed.

This description only teaches using the sensor as a switch and more specifically does not disclose the use as a variable power control device as stated by the examiner. Watson further states that if the sensor is not functional the device may be constantly energized by the battery or a manual on/off switch. There is no teaching or suggestion for the sensor to be used as a variable power control device, and Watson teaches away from the use of the sensor as a variable power control device. The applicant contends that the use of the light sensor, as disclosed in Watson, as a variable power control device is hindsight from the examiner.

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The applicant agrees that Dalton discloses a using a light detector to vary the amount of illumination from the light, but there is no motivation in Dalton to take the walkway light from Dalton and use it to illuminate a picture, artwork, or a street sign. The applicant agrees that they are combinable, but Watson does not disclose variable light intensity and teaches away from the light detector to vary the light intensity. There is further no disclosure in Dalton or in Watson to combine the products or the illumination function. The mere fact that a person skilled in the art "could" make such a change, that is, possesses the technical ability to make the change, given the direction to do so by the Applicant, does not make the claimed invention "obvious" under 35 U.S.C. 103. The direction to do so must be given by the prior art. Here the reasoning behind the rejection falls short, in short, a rejection cannot be based on assertion that it is "obvious to try" to make the change without any purpose other than to try, and a rejection cannot be based on hindsight reconstruction using the applicant's specification.

One is reminded that, a "person of ordinary skill in the art is presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate," Standard Oil Co. v. American Cyanamide Co., 774 F.2d 448, 445 [227 USPQ 293, 297-298] (Fed. Cir. 1985). And "Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital and Wells National Services Corp., (CAFC 1984), 221 USPQ 929, 732 F.2d 1572.

A prior art reference "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention..." It is error to "focus on isolated minutiae in a prior art patent while disregarding its scope, i.e., its entire disclosure, and how its disclosed structure works". Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1574, (1 USPQ2d 1593, 1597, 1602, (Fed. Cir. 1987).

*"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination*

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*other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination."* (citations omitted and emphasis added). Uniroyal Inc. v. Rudkin-Wiley, 837 F. 2d 1044, 1051 [5 USPQ2d 1434, 1438] (Fed. Cir. 1988).

- 2) Claim 1 has been amended to identify that only one light source is used and that the light source shines a beam of light onto the artwork or picture to illuminate a portion of the artwork or picture more brightly than other parts of the artwork or picture. The use of a single light to unevenly illuminate some of the picture or artwork is not found in any of the cited references. In Watson the illumination is with multiple lights illuminating from the top of the sign. In Yu, multiple light sources are placed around the frame to illuminate the entire license plate. In Dalton a reflector reflects the light evenly around the outdoor lighting device.
- 3) The Dalton reference is related to an outside walkway illumination device and the applicant contends that it would not be obvious to combine illumination of a walkway with illumination of a picture or image. The applicant further contends that the examiner has not shown motivation in a reference to combine the Dalton illumination with the street sign of Watson or the license plate of Yu.
- 4) With respect to claims 6, 13 and 17 the examiner cites that Watson teaches a flat sign with indicia thereon. In Watson the sign 7 is described as a name plate sign. The examiner uses Watson as a reference for citing that the image being illuminated is 3 dimensional and rises from the surface. The applicant

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request specific identification where in Watson it reference an image that is 3 dimensional that rises from the surface.

- 5) The examiner has rejected claims 23 and 24 as unpatentable over Watson, in view of Yu, Dalton et al., and Tanny et al. Tanny teaches sound production based upon a change of light intensity. There is no illumination in the Tanny et al., patent. The use of a light sensor in Tanny et al. is used to determine the when the sound activation begins. This is an entirely different use of the light sensor in the pending application where the light sensor changes the illumination on the picture or artwork. The use of the light sensor in Tanny et al., teaches away from the use of the light sensor in the pending application. Once again the examiner is using hindsight to combine references where they use one common element, the light sensor in this case, to combine Tanny et al., with the light sensor of the pending application.
- 6) The examiner has rejected claims 25 and 26 as unpatentable over Watson in view of Yu, Dalton et al., and Privas et al., to utilize motion to turn-on the illumination. In Privas et al., the display apparatus is not integrated into the frame of the artwork. The examiner is again using hindsight with the combine the references. The applicant requests the specific support where the motivation to combine exists in the cited references. In Watson in view of Yu, and Dalton et al., illumination already exist. The illumination is controlled by ambient light detection. There is no suggestion to include motion detection in these three references to combine them, individually or collectively, with Privas et al. While the applicant agrees that these features are combinable, there is

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no motivation to combine these references without the disclosure from the applicant.

Moreover, even patentable claims are made up of known elements. "That all elements of an invention may have been old is not unusual, and indeed, irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements." *American Medical Systems Inc. v. Medical Engineering Corp.*, 6 F.3d 1523, 28 USPQ2d 1321 (Fed. Cir. 1993).

The prior art must suggest the desirability to combine. "[T]he questions is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would 'suggest the desirability', and thus the obviousness, of making the combination." *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1498, 1 USPQ2d 1337, 1343 (Fed. Cir. 1986). In short, there is no suggestion that would lead one to combine the three references and limitations as identified by the examiner.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.  
(emphasis added)

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Words does not equate to a finding of obviousness. "[T]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the inventions as a whole for which patentability is claimed." *Hartness International, Inc. v. Simplicatic Engineering Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1832 (Fed. Cir. 1987).

The examiner has not shown where it is suggested to combine these features or where it is suggested that combining these features creates a reasonable expectation of success. The applicant request clarification where in the prior art the motivation and the reasonable expectation is found in the references, and not in the disclosure from the applicant.

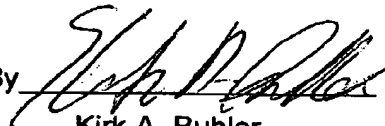
Independent claims 1, 8 and 15 are not obvious based upon the arguments made by the applicant. Claims 2-4, 6, 7, 11-14, 16, 18-20, 22-26 are not obvious based upon the arguments made regarding independent claims 1, 8, 15 and by virtue of their dependence on independent claims 1 8, and 15.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
BUHLER & ASSOCIATES

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By



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